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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,289	07/10/2001	Didier Arnoux	264/264	7287

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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

10

DATE MAILED: 03/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/868,289

Applicant(s)
Arnoux et al.

Examiner
Rabon Sergeant

Art Unit
1711



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 7, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-49 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s).
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7 6) ☐ Other

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1. Claims 21 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claims 21 and 34, applicants have failed to specify the basis for the claimed weight percent values. It is not clear if they are based on the weight of the prepolymer or the composition.

This issue was not addressed in the response to the previous Office action.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to

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the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 20-23, 27, 29, 33-36, 39, 41-43, 45, and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 6-16767.

The reference discloses a polyurethane composition comprising the reaction of a prepolymer, derived from toluene diisocyanate and polytetramethylene glycol, with DETDA, in the presence of phthalate or phosphate plasticizers, such as dioctyl phthalate, octyldiphenyl phosphate, and triphenyl phosphate. The reference further discloses that the reaction proceeds at temperatures which overlap those of applicants. See pages 1-5 and 7 of the translation.

4. Applicants' argument that the claims are distinguished from the reference, because the instant invention does not require the use of a catalyst is without merit. Applicants' claims are open to the inclusion of any component.

5. Claims 20-32, 37, 38, 40, 44, and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 6-16767, in view of Singh et al. ('371) and further in view of Rizk et al. ('860), Peter ('258), and Gabbard et al. ('956).

As aforementioned within paragraph 3, the primary reference discloses the production of polyurethanes, wherein a prepolymer, derived from toluene diisocyanate and polytetramethylene

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glycol, is reacted with a hindered aromatic diamine, in the presence of phthalate or phosphate plasticizers, such as dioctyl phthalate, octyldiphenyl phosphate, and triphenyl phosphate. The reference further discloses that the reaction proceeds at temperatures which overlap those of applicants. See pages 1-5 and 7 of the translation. Furthermore, the position is taken that it would have been obvious to utilize temperatures below those disclosed, thereby increasing pot-life, if one was unconcerned with the rapid processing times associated with reaction injection molding processes.

*6. ** The primary references are silent with respect to the dimethylthiotoluene diamine curing agent and specific plasticizers, such as isodecyl diphenyl phosphate, butyl benzyl phthalate, and tributoxyethyl phosphate; however, these components were known constituents of polyurethanes at the time of invention. Dimethylthiotoluene diamine was a known hindered diamine for curing toluene diisocyanate based prepolymers. See column 3, lines 61+ within Singh et al. Plasticizers corresponding to those claimed are disclosed within Gabbard et al. at column 4, Peter at column 2, lines 47-52, and Rizk et al. at column 6. The position is taken that it would have been obvious to incorporate the curing agent and plasticizers of the secondary references within the compositions of the primary reference, because it has been held that it is *prima facie* obvious to utilize a known component for its known function. *In re Linder*, 173 USPQ 356. *In re Dial et al.*, 140 USPQ 244.

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7. The examiner has considered applicants' argument that the instant invention represents a break-through in the art, because the compositions react at room temperature. However, this argument fails to appreciate the fact that the primary reference discloses reaction temperatures that overlap those claimed. The argument further fails to appreciate that it would have been obvious to conduct the reaction at lower temperatures, if one of ordinary skill was not concerned with rapid processing times.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.


RABON SERGENT
PRIMARY EXAMINER

• R. Sergent
March 15, 2003